

REMARKS

Claims 2-14, 22-26, 27 and 28 are currently pending in the application. Claims 2-14, 22-26, 27 and 28 are presently before the Examiner. By this Amendment, new Claims 27 and 28 have been added.

I. Claim Objections

Claims 10 and 13 were objected to for minor informalities. Claims 10 and 13 have been amended to address the informalities and withdrawal of the objection is respectfully requested.

II. Claim Rejections under 35 U.S.C. § 103

Claims 2-14 and 22-26 were rejected as allegedly being obvious over U.S. Patent No. 5,991,751 ("Rivette") alone, or in combination with U.S. Patent No. 6,556,992 ("Barney") and/or U.S. Patent Application Publication No. 2002/0147745 ("Houben"). Applicants respectfully traverse the rejections.

Rivette discloses patent-centric and group-oriented data processing. The groups may include non-patent information.

Barney discloses a method for rating the quality of patents.

Houben disclose a method for processing incoming documents using a markup language driven server.

a. The Prior Art is Nonanalogous

The particular context of the pending claims, that being legal services and attorney work product, are especially important and are entitled to patentable weight. If these features were not critical, then the West km product, which is encompassed by the pending claims, would not have enjoyed the significant commercial success or solved the addressed long-felt but unsolved need as set forth in prior responses.

The cited references do not deal with legal citations or legal documents. A “citation” is affirmatively recited by Claim 22 and is entitled to patentable weight. Citation in the presently claimed context of legal documents is generally understood to a citation to authority, such as caselaw. A dictionary definition (from www.freedictionary.com) appears below:

ci-ta-tion  (sī-tā'shən)

n.

1. The act of citing.

2.

a. A quoting of an authoritative source for substantiation.

b. A source so cited; a quotation.

3. ***Law A reference to previous court decisions or authoritative writings.***

4. Enumeration or mention, as of facts, especially:

a. An official commendation for meritorious action, especially in military service: *a citation for bravery.*

b. A formal statement of the accomplishments of one being honored with an academic degree.

5. An official summons, especially one calling for appearance in court.

(Emphasis added). The Office Action has failed to give any patentable weight to “citation.” The references of record such as Rivette, which are directed to patent search engines, simply work with patent documents. Legal documents are a highly specialized field (see para. 18 of the Supplemental Declaration of Donald Hayden under 37 C.F.R. §1.132 filed herewith, hereinafter the Supplemental Hayden Declaration). The particular context of the cited prior art is patent search engines and patent evaluation, which is far afield from storing, searching and displaying legal documents. Because of this lack of reasonable pertinence, the cited combination is not proper and withdrawal of the rejection is respectfully requested.

b. The Shortcomings of the Prior Art

There is nothing in either of these three cited references that discloses or suggests, either alone or in combination, in whole or in part, the method defined by Claim 10 of the subject application. In particular, Claim 10 recites, inter alia, a method including providing an interface for an online legal research service, wherein the interface enables an authorized law firm user to

view search results including both internal law-firm content including briefs, client correspondence, advisory opinions, or legal memoranda of the law firm and content of the online legal research service, wherein the search results are based on a single query submitted or initiated through the interface by the user, and wherein the internal law-firm content is generated by selectively converting documents retrieved from an internal law firm database into a markup language and then subsequently indexing the internal law-firm content based on citations and text to permit the internal law firm content to be searched and displayed on the interface. The prior art references do not include or suggest such limitations (see also paras. 19 and 20 of the Supplemental Hayden Declaration). Therefore, Claim 10 and each of the claims depending therefrom are not rendered obvious by the combination of references cited by the Examiner, and withdrawal of the rejection under 35 U.S.C. § 103(a) is respectfully requested.

Regarding Claim 9, it further recites, *inter alia*, that text including one or more selectable citations to other corresponding documents and with each citation associated with an indicator of current reliability of its corresponding document as a legal authority. Hence, a user can throw out unreliable hits in the search results (see also para. 21 of the Supplemental Hayden Declaration). The prior art references do not include or suggest such limitations. Therefore, for at least this additional reason, Claim 9 is not rendered obvious by the combination of references cited by the Examiner, and withdrawal of the rejection under 35 U.S.C. § 103(a) is respectfully requested.

Turning to Claim 22, the Office Action does not dispute that Rivette and Barney fail to teach indexing documents based on citations and text. Instead, at page 12, the Office Action alleges that this critical gap is filled by Paragraph 52 of Houben. As best understood, this is an

allegation that “citations” are an “intended use” of an XML markup language. As noted above, it is not proper to make the combination.

However, for the sake of argument, even if the three references were combined as suggested by the Examiner, the claimed invention would not be obtained. In particular, Claim 22 recites, *inter alia*, a computer system including means for searching at least first and second physical or logical databases for content related to the query, with the first database including a set of work-product documents of the law firm and the second database including non-work-product documents of the law firm. The prior art references do not include or suggest such limitations (see also paras. 19 and 20 of the Supplemental Hayden Declaration). Therefore, Claim 22 and each of the claims depending therefrom are not rendered obvious by the combination of references cited by the Examiner, and withdrawal of the rejection under 35 U.S.C. §103(a) is respectfully requested.

c. The Claimed Invention Solves a Long-Felt Need

In the Office Action, the Examiner requested dates relating to the long-felt need discussed in previous filings. The Supplemental Hayden Declaration is being submitted herewith to address, among other things, the timing issues related to the long-felt need that is addressed by the invention as embodied in the pending claims.

Long-felt but unsolved need is another indicia of non-obviousness. West km, a search engine that embodies the subject claims, filled a long felt need of being able to effectively search internal law firm databases and external online legal research with a single query as well as provide an indicator of current reliability of its corresponding document as a legal authority (see paras. 5-13 of the Supplemental Hayden Declaration). If it were so obvious, such features as recited in the claims would have been made available before introduction of West km to alleviate the frustration of law firms and

increase lawyer searching efficiency. It was not done beforehand despite these frustrations and inefficiencies. So for this additional reason, the subject claims are not obvious and withdrawal of the rejections is respectfully requested.

d. Commercial Success Establishes Non-obviousness

It is well settled that where there is question as to whether invention exists that extensive use and commercial success can resolve the question of patentability in favor of the applicant. The Supplemental Hayden Declaration also independently establishes the non-obviousness of the subject claims because of the tremendous commercial success of West km, which embodies the features of the subject claims (see paras. 14-17 of the Supplemental Hayden Declaration). Mr. Hayden attests to the extensive use and commercial success of West km because of the claimed features (see paras. 14-17 of the Supplemental Hayden Declaration).

In view of the Supplemental Hayden Declaration, West km has been widely accepted in a competitive marketplace since introduction. The reason for this market penetration is directly attributable to the features claimed in the subject application. In short, when considered as a whole, the subject claims are a non-obvious innovation in view of the commercial success. If this combination were obvious, the competitors would have previously utilized it. They did not and, thus, the combination is not obvious. As such, it is respectfully submitted that a nexus has been demonstrated between the features of the pending claims and the commercial success, which would rebut any prima facie case of obviousness, assuming for the sake of argument that one actually existed.

In view of the discussion above (particularly in view of the Supplemental Hayden Declaration), the pending claims are not rendered obvious by the three reference combination, for at least the reasons noted, and withdrawal of the rejections under 35 U.S.C. § 103 (a) is respectfully requested.

e. New Claims 28 and 29

Applicant has added new Claims 28 and 29 which are directed to additional patentable aspects of the subject invention. Applicant respectfully submits that new Claims 28 and 29 patentably distinguish over the art of record, and allowance of this claims is respectfully requested.

CONCLUSION

Applicants respectfully request allowance of this application. The Director is hereby authorized to charge any fee deficiency associated with this paper (or with any paper filed in this application by this firm) to our Deposit Account No. 04-1105, under Order No. 85192(307534).

Respectfully submitted,

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